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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,525	10/16/2003	Fergus Rupert Fitzgerald	P67027US1	3990
136	7590	03/17/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,525

Applicant(s)

FITZGERALD, FERGUS RUPERT

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/929,051.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 28-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4300319 C1 Hagen English abstract referenced in combination with the teachings of US Pat. No. 5576384 Nolken et al., US Pat. No. 3907725 Forte et al., and US Pat. No. 3164562 Breed.

Hagen discloses coating compositions containing the instantly claimed materials and amounts thereof, except for the biocide/preservative. It is noted that the translated example uses about 864 parts calcium carbonate, 0.9% EVA, 0.12 cellulose thickener, 0.005% dispersant, and 0.05 % TiO₂. Considering the amounts used in examples II and III which can be translated using the amounts of translated example I, Hagen encompasses the use of the instantly claimed amounts of thickener and surfactant. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed preservative of claims 28, 49, and 51 in the compositions of Hagen because it is well known that EVA and cellulose are subject to microbial attack and Nolken shows such amounts of Na Benzoate to protect similar compositions from such attack at column 5, lines 11-15 and column 11, lines 52-55. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed Na Citrate in the compositions of Hagen because Breed shows these amounts of Na citrate to buffer EVA emulsions at column 2, lines 1-18 and this buffering will give the benefits it gives to the EVA of Breed as well as the Na citrate will necessarily function as an anionic emulsifier due to its inherent HLB. It would have been obvious to one of ordinary skill in the art

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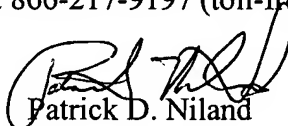
at the time of the instant invention to use the instantly claimed amounts of attapulgite in the compositions of Hagen because Hagen states that silicate-carbonates may be used, attapulgite is a silicate which will complex with the calcium carbonate present and will give the thickening as taught in Forte et al.(claim 1). It would have been obvious to one of ordinary skill in the art at the time of the instant invention to mix the above discussed components according to the instant claims because the addition of the materials of Hagen in any order is expected to yield the same composition and In re Hampel, 74 USPQ 171 held that the sequence of mixing ingredients is within the skill of the ordinary skilled artisan. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed amount of water of claim 32 because Hagen discloses using water and the amount of water will give only predictable results such as a predictable viscosity and it is within the ability of the ordinary skilled artisan to vary the viscosity within wide ranges to give the properties desired. The use of the coating of Hagen in a pasty form would be expected to make a good joint sealer according to the teachings of Nolken and Forte. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to apply the above discussed compositions according to the instant claims 36-54 because brushing and rolling are the most conventional ways to apply coatings.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
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